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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,397

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Peter Richard Van Smirren

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EXAMINER

LARSON, JUSTIN MATTHEW

ART UNIT

PAPER NUMBER

3782

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,397	Applicant(s) VAN SMIRREN, PETER RICHARD	
	Examiner Justin M. Larson	Art Unit 3782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-23 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-16 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/23/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I in the reply filed on 3/8/10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 17-22 have been withdrawn from further consideration as being drawn to a nonelected invention.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 6/23/06 is noted. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement. AU 4708085 A has been lined through because Applicant did not provide a copy of the reference and Examiner was unable to find the document himself. Examiner was able to locate the other two foreign references and they have been considered.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fixing member being adapted to be hooked under a part of the vehicle roof, as set forth in claim 23, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 11 is objected to because Examiner believes it should depend from claim 10 and not claim 8. It is claim 10 that sets forth the gap hider mentioned in claim 11, not claim 8. Appropriate correction or clarification is required.
5. Claim 15 is objected to because it appears that Applicant has not finished the claim and it does not further limit claim 14 from which it depends. Appropriate correction or clarification is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1, 3, 5-16, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 12, and 14, the phrase “and/or” does not distinctly claim a particular structure and renders the scope of the claims indefinite.

In claim 12, it is not clear whether the term "including" means that other methods of treating are within the scope of the claim or if only those methods of treating that are claimed are within the scope of the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3, 5-11, 13-16, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobsen et al. (US 4,792,180 A).

Regarding claims 1, 3, 5-7, and 14-16, Jacobsen disclose a method of attaching a load carrier fixing member (42 which can be considered a roof rail or trim finisher) to a vehicle, the method comprising applying adhesive (56) to the vehicle roof (12), and attaching the fixing member to the vehicle (Figure 2), for subsequent attachment of a load carrier (such limitation being completely functional where a load carrier such as a roof rack could be attached to the trim finisher 42 of Jacobsen if a user so desired, this

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idea supported by Applicant's own claim 8), the fixing member comprising a surface with at least one undercut (58).

Regarding claims 8 and 9, a fixing member trim finisher (68) is removably attached to a non-adhered side of the fixing member (see Figure 3).

Regarding claims 10 and 11, the fixing member comprises at least one gap hider (50,52) that is positioned between the fixing member and the vehicle.

Regarding claim 13, the fixing member is secured in position using one or more locating members (50,52) which are shaped to hold the fixing member in place (maintains side-to-side position within gap).

Regarding claim 23, a portion (66) of the fixing member is adapted to be hooked under a pair of the vehicle roof (see Figure 3).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen et al. in view of Beecher et al. (US 4,904,328 A).

Jacobsen discloses the method as claimed except for the step of cleaning the part (roof) of the vehicle to be worked on. Beecher, however, teaches that it was already known in the art to clean a bonding surface by sanding and/or wiping in order to increase the adhesive potential of the bond (see abstract and col. 1 lines 19-21). While

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Beecher focuses on FRP vehicle parts, one of ordinary skill in the art, after studying Beecher, through their own available knowledge and reasoning, would realize that such surface cleaning could be useful in just about any situation where bonding was needed, not limited to FRP parts. Thus it would have been obvious to one having ordinary skill in the art at the time the invention was made to have cleaned the roof of Jacobsen before applying the adhesive, the motivation being to increase the adhesive potential in the manner taught by Beecher.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20020035863 - dovetail/adhesive, [0035]

4582738 - grooves 21 adhesive 11

4593878 - dovetail indents and adhesive, see Figures

20030168889 - adhesive 10

6345859 - gap hiders 13

4930279 - locating members 23 at spaced locations

5540478 - adhesive 14

4842176 - undercut 50

4618181 - adhesive 6

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571)272-8649. The examiner can normally be reached on Monday-Friday, 9a-5p (EST). If

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin M Larson/
Examiner, Art Unit 3782
5/3/10